

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MICHAEL LEE VATTER

Appeal 2008-0141
Application 09/902,048
Technology Center 1600

Decided: December 12, 2007

Before DEMETRA J. MILLS, ERIC GRIMES, and RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Claim 1 is representative.

1. A method for removing transfer resistant make-up compositions comprising the step of applying a safe and effective amount of a make-up removing composition comprising:

(i) from about 0.1 to about 30% of a non-spherical crosslinked siloxane elastomer said elastomer having a particle size of from above 10 to about 200 microns;

(ii) from about 10 to about 80% of a solvent suitable for topical application to the skin having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2};

(iii) optionally, from about 0% to about 90% water and;

(iv) an emulsifier;

wherein the composition has a viscosity greater than about 20,000 cps.

Cited References

Fowler	US 5,534,265	Jul. 9, 1996
Schulz	US 5,654,362	Aug. 5, 1997
Drechsler	US 6,071,503	Jun. 6, 2000

Grounds of Rejection

Claims 1-6 and 8-12 stand rejected under 35 U.S.C. § 103 as obvious over Schulz in view of Drechsler and Fowler (Answer 3).

DISCUSSION

Background

The claimed invention relates to a cleansing composition which is described as suitable for topical application to human skin, more particularly to an oil-based cleansing composition containing a silicone elastomer gelling agent for removal of make-up from the skin. (Specification 1.)

According to the Specification, preferably the cross-linked siloxane elastomer is non-spherical. (Specification 8.) “[S]pherical particles fail to provide the rheology and film properties necessary to achieve the benefits of the present invention. Specifically, when forming the gel matrix or network, spherical particles do not swell to the extent and/or pack as tightly as non-spherical particles.” (Specification 8.)

Obviousness

Claims 1-6 and 8-12 stand rejected under 35 U.S.C. § 103 as obvious over Schulz in view of Drechsler and Fowler.

The Examiner contends that it would have been *prima facie* obvious to one of ordinary skill in the art “to incorporate the silicone elastomer disclosed by Schulz into a petrolatum or dimethicone-based cosmetic remover in order to benefit from the removal of transfer resistant makeup as taught by Drechsler.” (Answer 3.) The Examiner assumes that the silicone elastomer of Schulz has the claimed properties (Answer 7), i.e., that it is in non-spherical form and has a particle size of from above 10 to about 200 microns.

Appellant contends that “Schulz, Drechsler, and Fowler do not teach or suggest a method for removing transfer resistant make-up compositions comprising from about 0.1 to about 30% of a *non-spherical* crosslinked siloxane elastomer having a particle size of from about 10 to about 20[0] microns.” (Br. 4.)

The Examiner’s obviousness conclusion is in error. Inherent anticipation requires that the claimed subject matter “necessarily and

inevitably” occur. *See Schering Corp. v. Geneva Pharmaceuticals*, 339 F.3d 1373, 1378 (Fed. Cir. 2003). “Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claims limitations, it anticipates.” (*Id.*) *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999).

In the present case, we do not find the Examiner has presented sufficient evidence that the silicone elastomer of Schulz is necessarily non-spherical or that it necessarily has the claimed particle size. According to the Specification, silicone elastomer particles may be spherical or non-spherical, and it is the non-spherical form of silicone elastomers that are required in the claimed invention. (Specification 8: “Preferably, the cross-linked siloxane elastomer is non-spherical. . . . [S]pherical particles do not swell to the extent and/or pack as tightly as non-spherical particles.”) The Examiner has not established with sufficient evidence that the particles of Schulz are necessarily non-spherical.

The Examiner notes (Answer 4, n. 1) that the instant Specification states that “[c]ross-linked organopolysiloxane elastomers useful in the present invention . . . are further described in . . . US Patent 5,654,362 to Schulz” (Specification 6: 26-29). However, the Specification also states that the cross-linked organopolysiloxane elastomers should be further processed by “discrete pass processing” and not “recycled processing” in order to achieve the particle size distribution recited in the claims:

The cross-linked organopolysiloxane elastomers of the present invention are preferably further processed by subjecting them to a high shear . . . treatment in the presence of a solvent for the siloxane elastomer via a Sonolator at less than 10 passes. Sonolation achieves a resultant composition with elastomer

average particle size ranging from above 10 (or above about 10) microns to about 200 microns.

(Specification 6: 33 to 7: 3.) “[D]iscrete pass processing, as alluded to above, ensures that all the particles experience shear . . . with each run or pass,” resulting in particles that have a narrower size distribution with better “skin feel and viscosity” (Specification 7-8).

By contrast, the Specification states that, when cross-linked organopolysiloxane elastomers are subjected to “recycled processing,” size distributions result which comprise “particles larger or smaller than that necessary to achieve the skin feel benefits of the present invention” (Specification 7: 17-20). “Specifically, gel balls often result from silicone elastomer particles larger than 200 microns while elastomer particles smaller than 10 microns reduce skin feel and viscosity benefits” (Specification 7: 20-22). The claims are restricted to silicone elastomers having a particle size of from above 10 to about 200 microns.

The powder described by Schulz is made by crumbling a silicone gel into a silicone powder using mechanical force (Schulz, col. 1, ll. 60-61). The Examiner has not established with sufficient evidence that the powder described in Schulz necessarily has a particle size of from above 10 to about 200 microns or that the silicone elastomer particles are non-spherical. Powders, by definition, have a maximum dimension of less than 1000 microns. *Grant and Hackh's Chemical Dictionary*, McGraw Hill Book Company, New York, p. 469 (1987) and thus do not inherently meet the claimed limitations. In addition, as discussed above, the Specification describes specific conditions for achieving the claimed particle size. (Specification 7-8). There is no evidence that Schulz utilizes these

conditions, e.g., using “discrete pass processing” and avoiding “recycled processing.” We do not find that the secondary references, Drechsler and Fowler make up for this deficiency in Schulz.

In view of the above, the obviousness rejection is reversed.

SUMMARY

The rejection of claims 1-6 and 8-12 under 35 U.S.C. § 103 as obvious over Schulz in view of Drechsler and Fowler is reversed.

REVERSED

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